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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,406	12/03/2003	Jack Wang	WANG157	4745
1444	7590	11/15/2005	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/725,406

**Applicant(s)**

WANG, JACK

**Examiner**

William P. Watkins III

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

1. Applicant's election of Group II, claims 12-20 in the reply filed on 24 February 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement in either the paper filed 24 February 2005 or the paper filed 30 August 2005, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 21-24 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of Huang (U.S. 2003/0198803) further in view of Hawley et al. (U.S. 6,221,796).

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Chen et al. teach a perforated felt with a polyurethane coating that fills the perforations (Figure 3, abstract, section (0012)). Huang teaches the use of a foam EVA material instead of felt as the backing for a polyurethane top layer in order to provide better cushioning (abstract). Hawley et al. teaches a scrim coated with foam in order to provide a reinforced cushioning layer with through holes (abstract, col. 1, lines 30-45). The instant invention claims a scrim with an EVA polymer coating and through holes in the EVA coated scrim, that are filled with a second polymer that may be polyurethane. It would have been obvious to one of ordinary skill in the art to have used a perforated EVA base instead of perforated felt in the laminate of Chen et al. in order to provide better cushioning because of the teachings of Huang while still providing for dimple formation. It further would have been obvious to one of ordinary skill in the art to have substituted an EVA foam covered scrim for the perforated EVA layer of Chen et al. in view of Huang in order to reinforce the layer because of the teachings of Hawley et al.

4. Claims 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of

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Huang (U.S. 2003/0198803) further in view of Hawley et al. (U.S. 6,221,796) as applied to claims 21-24 and 28-29 above, and still further in view of Kobe et al. (U.S. 6,372,323 B1).

Chen et al. as modified above teaches a perforated EVA coated scrim layer with a polyurethane coating. Kobe et al. teach the use of non-woven fabric and other layers as reinforcement backings behind grip strips (col. 5, lines 15-50, col. 1, lines 55-65). The instant invention claims a perforated grip strip with a non-woven backing. It would have been obvious to one of ordinary skill in the art have used a backing layer on the grip strip of Chen et al. as modified above in order to reinforce the strip because of the teachings of Kobe et al.

5. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. 2004/0109980) in view of Huang (U.S. 2003/0198803) further in view of Hawley et al. (U.S. 6,221,796) as applied to 21-24 and 28-29 above, and still further in view of Spector (U.S. 4,567,091).

Chen et al. as modified above teaches a perforated EVA coated scrim layer with a polyurethane coating. Spector teaches the use of skin layers on both sides of a foam layer in order to seal it and provide better cushioning (abstract). The instant

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invention claims a perforated layer coated and filled from both sides by a second polymer. It would have been obvious to one of ordinary skill in the art to have coated the strip of Chen et al. as modified above on both sides to enhance cushioning because of the teachings of Spector.

6. Applicant's arguments filed 30 August 2005 have been fully considered but they are not persuasive.

Applicant argues that Chen et al. does not teach a scrim layer. This limitation is supplied by the Hawley reference. Applicant further argues that combining Hawley et al. with Chen et al. would not be done by one of ordinary skill in the art because the references are from different art areas and the function of the references would be destroyed. The examiner first notes that that Hawley et al. is not directly combined with Chen et al., but instead is combined with the combination of Chen et al. in view of Huang. The combination of Chen et al. in view of Huang produces an EVA foam structure with through holes and an outer polyurethane coating which covers the outer surface of the foam structure and fills the through holes. Thus both the combination of Chen et al. in view of Huang and the Hawley reference have the common problem of providing an EVA

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layer which cushions and has adequate strength to remain intact during use. Hawley solves this problem by providing the EVA layer as a coating on a woven scrim, which reinforces the EVA layer while also providing through holes. Thus the references are analogous art and can be combined.

Applicant also argues that using this type of reinforcement would destroy the function of Chen et al. in view of Huang. The examiner does not agree, as there would still be through holes for filling with the second polymer if a scrim were used for reinforcement. Applicant argues that the function of Hawley et al. would be destroyed because filling the scrim of Hawley et al. with the outer layer of Hawley would destroy the outer layer. The examiner does not find this persuasive as the coated scrim of Hawley is taught as being stand alone in the prior art described by Hawley and further the examiner is only transferring the scrim reinforcement of Hawley et al. to the combination and does not seek to further modify the reference by filling the scrim holes with the outer layer of Hawley as argued by applicant.

Regarding Chen et al. in view of Huang, applicant argues that there are only random holes and not array of oval holes. The holes of Figure 1 of Chen et al. appear to be an array of

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oval holes to the examiner. The examiner also notes that the scrim of Hawley et al., which would also form the holes in the combination of Chen et al. in view of Huang further in view of Hawley, teaches a curved opening (element 24) that has a long axis and could be considered as a type of oval.

Regarding the combination with Kobe et al. applicant argues that Kobe has nothing to do with the other references. The examiner disagrees as Kobe et al. is directed to backing layers for grip devices. Forming a grip device is the purpose of the combination of Chen et al. in view of Huang further in view of Hawley. Thus the references have common subject matter.

Regarding the combination with Spector, applicant again argues that there is no motivation to combine because Spector does not have through holes. The examiner relies upon the teaching of outer layer on both sides to seal the inner foam and provide better cushioning. Thus there is motivation to make the combination.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is



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reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. This application contains claims 1-11 drawn to an invention nonelected with traverse as noted above. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally

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be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WW/ww

November 10, 2005

**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**